

## REMARKS

### STATUS OF THE CLAIMS

Claims 39-41 and 46-78 are pending in this application. Claim 39, 59 and 69 were amended.

### INTERVIEW SUMMARY

Applicant, Robert Otilar, and Examiner Ludlow had a telephonic interview on July 31, 2007. The Examiner indicated that the prior art rejection included in the prior Office Action of March 1, 2007 was issued in error. The Examiner mailed a new Office Action resetting the due date for response and removing all prior art rejections. The Applicant explained to the Examiner the meaning of the "wherein the magnitude..." language and where support was provided in the specification. The Examiner agreed and requested that the Applicant also provide this explanation in writing in this response. Applicant has included this explanation below.

In the interview of July 31, 2007, the Examiner also suggested that the Applicant could remove the "wherein...discrete and predetermined" language from claim 59 as this is not required for patentability. Applicant has removed this language per the Examiner's suggestion.

In the interview of July 31, 2007, Applicant further noted that the Examiner had previously made a suggestion as to how the Applicant could overcome the restriction requirement between Groups IIIa (39-41, 46-58, 74-75, 77) and IIIb (59-73, 76, 78), which was issued on October 5, 2006. In the interview of August 11, 2005 between the Examiner and Robert Otilar, the Examiner suggested that he add the detecting step to claim 59, similar to the detecting step that appears in claim 39, and this would overcome the restriction requirement. The Applicant followed the Examiner's advice and made this amendment to claim 59 in his response of August 11, 2005. He further explained in his interview summary why he had made this amendment and his prior discussion with the Examiner. However, the Examiner then re-issued the restriction requirement again over a year later in the Office Action of October 6, 2006, possibly in error. Applicant responded to that restriction requirement, but during the interview of July 31, 2007, Applicant described this issue to the Examiner. The Examiner agreed to reconsider the restriction requirement and asked the Applicant to provide this explanation here.

Thus, Applicant, following the Examiner's prior suggestion, has left in claim 59 the

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language regarding the detecting step that the Examiner said would overcome the restriction requirement. Applicant respectfully requests that the Examiner remove the restriction requirement between Groups IIIa and IIIb, thereby merging these Groups and removing withdrawal of claims 39-41, 46-58, 74-75, 77. Applicant thanks the Examiner for her time and consideration of his arguments.

### **RESTRICTION REQUIREMENT**

Per the explanation provided above regarding the interview summary, Applicant respectfully requests that the Examiner withdraw the restriction requirement requiring election between Groups IIIa (39-41, 46-58, 74-75, 77) and IIIb (59-73, 76, 78) and instead merge these groups as a single Group III. The Applicant made the amendments to claim 59 to add the detecting step in a prior office action specifically upon the Examiner's suggestion that this would overcome the restriction requirement. Applicant also requests that the Examiner remove withdrawal of claims 39-41, 46-58, 74-75, 77. Applicant has indicated herein that these claims are again pending.

### **CLAIM OBJECTIONS**

The Examiner objected to claim 69 because of a minor informality and the Applicant amended the claim to correct this typographical error.

### **REJECTIONS UNDER 35 U.S.C. 112, FIRST PARAGRAPH**

The Examiner rejected claims 59-73, 76, and 78 because of the language "discrete and predetermined." Applicant respectfully disagrees for the reasons previously stated. Per the Examiner's suggestion, Applicant removed this language from claim 59 as the Examiner stated this is not necessary for patentability.

Applicant also deleted this "discrete and predetermined" language from claim 39 and replaced it with language specifying that the particle is a known particle. The Examiner noted that the claim does not state that a predetermined particle is not localized. Thus, the Applicant has added this language as suggested by the Examiner. *See* Office Action, p. 4. This language is supported throughout the specification as filed, as explained in detail in the Office Action Response of August 11, 2005, p. 15.

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The Examiner also found that there is no support for “wherein the magnitude...of the uniform field,” and requested that the Applicant provide an explanation of this support, as discussed in the interview of July 31, 2007. As discussed in the telephone interview, Section [0145] cited by the Examiner, discusses, for example, “forces can be advantageously increased or altered by coordinating external elements or fields”, “uniform magnetic field that increases the force”, etc.

#### **PRIOR ART**

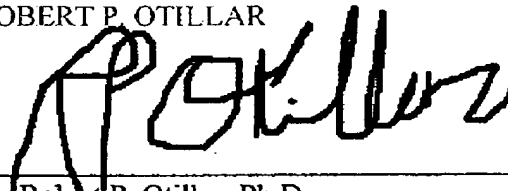
Applicant notes the Examiner’s statement that claims 59-73, 76, and 78 define over the prior art. Applicant has addressed the few remaining rejections, and thus respectfully requests that the Examiner allow these claims. In addition, Applicant respectfully submits that claims 39-41, 46-58, 74-75, 77 should be allowed over the prior art for the reasons set forth in detail in the Office Action Response of August 11, 2005, and as discussed a number of times in detail in the prior interviews with the Examiner. Thus, Applicant respectfully requests allowance of these claims, as well. Specifically, Applicant requests allowance of claims 39-41 and 46-78.

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## CONCLUSION

Withdrawal of the pending rejections and reconsideration of the claims as amended are respectfully requested, and a notice of allowance is earnestly solicited. If the Examiner has any questions concerning this Response, the Examiner is invited to telephone Applicant at (415) 317-2008.

Respectfully submitted,  
ROBERT P. OTILLAR



Dated: November 5, 2007

Signed: \_\_\_\_\_

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